



1-14, 17-19, 48, 50, 57

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Cerami *et al.*

Application No.: 09/259,929

Filed: March 1, 1999

For: METHODS AND DEVICES FOR  
MODULATING THE IMMUNE RESPONSE

Group Art Unit: 1617

Examiner: Edward J. Webman

Attorney Docket No.: 10162-004-999

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**PROVISIONAL ELECTION UNDER 37 C.F.R. § 1.143 WITH TRAVERSE**

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

In response to the Office Action mailed on October 31, 2001, (the "Office Action") in which a requirement for an election of species was imposed, Applicants respectfully request that the following remarks be considered and entered into the file of the above-identified application. A petition for an extension of time for one (1) month is attached.

**REMARKS**

Claims 1-57 are pending in the present application. Claims 20-47 and 51-54 have been withdrawn from consideration by the Examiner.

In the office action, at page 2, it is stated that

This application contains claims directed to the following patentably distinct species of the claimed invention: a method for inducing or enhancing an immune response, a method of suppressing or down regulating an existing or potential immune response, a method of immunizing for the preparation of a hybridoma.

In the Office Action, the Examiner has imposed a species election for prosecution on the merits under 35 U.S.C. § 121, and has required a listing of all claims readable upon the elected species.

In response, Applicants hereby provisionally elect, with traverse, a method for inducing or enhancing an immune response as the identified species for prosecution on the merits. Applicants submit that claims 1-14, 17-19, 50, and 57 are readable on the elected species.

Applicants respectfully traverse this requirement for species election. Specifically, Applicants request a modification of the election requirement so that species of the invention directed to methods for inducing or enhancing an immune response (readable on claims 1-14, 17-19, 50, and 57), and for methods of suppressing or down regulating an existing or potential immune response (readable on claims 15, 16, 55 and 56), be combined and examined together. Applicants submit that a search of the prior art for the elected species will necessarily yield any relevant prior art for the species directed toward methods of suppressing or down regulating an existing or potential immune response. Accordingly, Applicants respectfully submit that the search and examination of claims 1-19, 50, and 55-57 together would not seriously burden the Examiner. Therefore, Applicants request that the subject matter of claims 1-19, 50, and 55-57 be examined together.

Attorneys for Applicants retain the right, under 37 C.F.R. § 1.144, to petition from the election requirement.

#### CONCLUSION

Applicants respectfully request that the present remarks be entered and made of record in the present application. An early allowance of the application is earnestly requested. If any issues remain in connection herewith, the Examiner is respectfully invited to telephone the undersigned to discuss the same.

Applicants do not believe there is a fee due, other than that for an extension of time for one month, in connection with this response. However, should the Patent and Trademark Office determine otherwise, please charge the required fee to Pennie & Edmonds LLP Deposit Account No. 16-1150.

Respectfully submitted,

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Date December 4, 2001

By *Michael J. Bryan Reg No 41283* 30,742  
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*Enclosure*